



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO: 45	FILING DATE: 01/98	ZAMB FIRST NAMED INVENTOR	R	ATTORNEY DOCKET NO: 999
--------------------	--------------------	---------------------------	---	-------------------------

HM21/0526

PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

ACHUTE EXAMINER HY. P

ART UNIT: 3

PAPER NUMBER

05/26/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/009,846

Applicant(s)
Zambias et al

Examiner
P. Achutamurthy

Group Art Unit
1648



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 09/009,846

Art Unit: 1648

DETAILED ACTION

Drawings

The drawings filed with this application have been approved by the PTO draftsman and by the examiner for examination purposes. Please see the attached copy of PTO-948.

Election/Restriction

It is noted that claims drawn to compound arrays, methods of making compound arrays, and several methods of use were presented in the parent application 08/375,838. However, in the present case although there are three inventions respectively drawn to a compound array, method of making a compound array and method of using a compound array for identification of a compound having a property of interest, these are deemed to be drawn essentially to the same compound as that recited in claims 1-9, and the array of compounds is deemed to be clear of prior art, no restriction requirement is being imposed. Accordingly claims 1-15 have been examined on their merits.

Claim Rejections - 35 USC § 112

Rejection A

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific compounds disclosed in the specification, does not reasonably

Art Unit: 1648

provide enablement for compound arrays comprising molecular constructs of undefined and unspecified chemical characteristics.. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. It is noted that specific building blocks are used which have functionalities that will enable attachment of certain specific chemical moieties are taught in the specification. However, without any delineation of the types of compounds in the array persons having ordinary skill in the art would not be able to make compound arrays without knowing what starting core compound and what diversity elements are to be employed, in the absence of adequate guidance from the instant specification. Additionally, reciting such vague and indefinite terms as "common molecular core" and "variable structural diversity element in the claims fails to properly define the meets and bounds of the claimed invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1648

Rejection B

Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. Serial number 08/439,577 (allowed but not yet issued). Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims and referenced claims are drawn essentially to the same compound array having a core molecule and structural diversity elements attached to it and while the instant claims require that the arrays differ from one another by either zero or one change in a structural diversity element, this stipulations reads on the requirement in the patent claims that the arrays has "at least one structural diversity element which is different from the others" (see claim 1 for example). With respect to various core molecules and structural diversity element specified in the claims, of the referenced copending application the present claims are so generic as to encompass them. Accordingly it is believed that the instant claims and the patent claims are obvious variants of substantially the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection C

Claims 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,712,171. Although the

Art Unit: 1648

conflicting claims are not identical, they are not patentably distinct from each other because the both instant claims and referenced claims are drawn essentially to the method of reacting a core molecule with structural diversity elements and while the instant claims require that the arrays differ from one another by either zero or one change in a structural diversity element, this stipulations reads on the requirement in the patent claims that the arrays has "at least one structural diversity element which is different from the others" (see claim 1 for example). With respect to various core molecules and structural diversity element specified in the patent claims, the present claims are so generic as to encompass them. Accordingly it is believed that the instant claims and the patent claims are obvious variants of substantially the same invention.

Rejection D

Claims 14 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 5,736,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are drawn to a method of optimizing the ability of chemical compound to bind to a reaction site, and the method of identifying a chemical compound having a property of interest both encompass screening the compounds in the array for a selected activity of the compound of interest.

Serial Number: 09/009,846

Page 6


Art Unit: 1648

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1648**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Achutamurthy whose telephone number is (703) 308-3804. The examiner can normally be reached on Monday-Thursday from 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., can be reached on (703) 308-0570. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


PONNATHAPURA ACHUTAMURTHY
PRIMARY EXAMINER
GROUP 1800

pa
May 25, 1998